

REMARKS

Applicant thanks the Examiner for carefully considering the application. Please reconsider the application in view of the above amendment and the following remarks.

Decision by the Board of Patent Appeals and Interferences

On appeal, the Board reversed the Examiner's rejection of claims 10, 11, and 15–19 under 35 U.S.C. §102(b) and claims 12–14 under 35 U.S.C. §103(a). Nonetheless, the Board maintained the Examiner's rejection of claims 10–19 under 35 U.S.C. §112, first paragraph as lacking proper written description.

Thus, the only rejection remaining in the Present Application is the rejection of claims 10–19 under 35 U.S.C. §112, first paragraph as lacking written description. Accordingly, Applicant respectfully amends claim 10 and traverses the 35 U.S.C. §112 rejection as follows.

Claim Amendments

Claim 10 is amended by this reply to clarify the subject matter disclosed. As supported in the original specification, claim 10 now recites that torque is applied to the connection such that plastic deformation does not occur *prior to* final make-up. No new matter is added by this amendment.

Rejections under §112

The Board affirmed the 112 rejection set forth by the Examiner. In particular, the Board opined that “[t]he Appellants’ specification describes only that ‘torque may be applied to the positive torque shoulder prior to final make up, without causing irreversible plastic

deformation.” (emphasis added) Therefore, the Board concluded that the limitation in claim 10, directed to a method “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup,” was not properly supported under the written description requirement in the first paragraph of 35 U.S.C. §112. (Decision on Appeal, pp. 7–8).

In response, Applicant has amended independent claim 10 to recite “prior to final make up” as suggested by the Board. Therefore, Applicant asserts that the amendment to claim 10 described above is sufficient to overcome the rejection of claims 10–19 under 35 U.S.C. §112.

Furthermore, Applicant respectfully asserts that no new matter would be added by entry of the requested amendment. Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application (*i.e.*, the claims) *without* introducing new matter. MPEP §2163.06. As such, proper support for the claim amendment (“prior to” in place of “upon”) is found in the original specification (as acknowledged by the Board) and the amendment merely reconciles this informality.

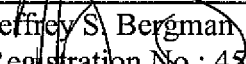
Accordingly, Applicant asserts that the rejection under 35 U.S.C. §112, first paragraph is now moot and that claims 10–19, as amended, are allowable.

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591, Reference No. 09432/183002.

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Respectfully submitted,

By: _____


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